

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB SEPT 29, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rack Room Shoes, Inc.

Serial No. 75/123,945

E. Thomas Watson of Parker, Poe, Adams & Bernstein L.L.P. for
Rack Room Shoes, Inc.

Elizabeth A. Dunn, Trademark Examining Attorney, Law Office 109
(Deborah S. Cohn, Managing Attorney).

Before Hohein, Chapman and Wendel, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Rack Room Shoes, Inc. has filed an application to
register the mark "SAHARA" for "shoes".¹

Registration has been finally refused under Section
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that
applicant's mark, when applied to its goods, is likely to cause
confusion, mistake or deception because it so resembles the mark
"SAHARA CLUB" and design, which is registered, as reproduced
below,

¹ Ser. No. 75/123,945, filed on June 24, 1996, which alleges a bona
fide intention to use the mark in commerce.

SAHARA CLUB



by the same registrant for, inter alia, the following goods:²

(i) "mens and womens wearing apparel--namely, pants: rain pants, jeans, slacks, dress shirts: knitted and woven sport shirts; oversized shirts; T-shirts, lounge and occasional sport jackets made of knitted woven materials; suits; knitted and woven sweaters; dresses; skirts; blazers, neckwear such as neckties and scarfs, hats and belts";³ and

(ii) "boys, girls and infants wearing apparel--namely, pants; rainpants, jeans, slacks, dress shirts; knitted and woven sport shirts; oversized shirts; T-shirts, lounge and occasional sport jackets made of knitted woven materials; suits; knitted and woven sweaters; dresses; skirts; blazers, neckwear such as neckties and scarves; hats, and belts".⁴

² Although registrant is also the owner of Reg. No. 1,717,118, issued on September 15, 1992, for the same mark for "footwear, namely shoes, slippers, athletic shoes and sneakers" and which sets forth a date of first use anywhere of May 1, 1991 and a date of first use in commerce of May 30, 1991, it is not possible at this time to determine if the registration is still subsisting or if it will be cancelled in due course for failure of the registrant to file an affidavit pursuant to Section 8(a) of the Trademark Act, 15 U.S.C. §1058(a). Consequently, while the Examining Attorney also cited such registration as a bar under Section 2(d) and finally refused registration to applicant in view thereof, we have not further considered the registration other than to note that it underscores the closely related nature of registrant's other goods to applicant's shoes.

³ Reg. No. 1,294,472, issued on September 11, 1984, which sets forth dates of first use of October 31, 1980; combined affidavit §§8 and 15.

⁴ Reg. No. 1,400,464, issued on July 8, 1986, which sets forth a date of first use anywhere of April 1, 1985 and a date of first use in commerce of July 1, 1985; combined affidavit §§8 and 15.

Applicant has appealed. Briefs have been filed,⁵ but an oral hearing not requested. We affirm the refusal to register.

We note, as a preliminary matter, that applicant does not take issue with the Examining Attorney's conclusion that shoes and various items of clothing are so inherently related that their sale under the same or substantially similar marks would be likely to cause confusion as to source or sponsorship. As the Examining Attorney points out, the Board has consistently determined that shoes and wearing apparel are related goods which are sold through the same channels of trade to the same customers. See, e.g., In re Kangaroos U.S.A., 223 USPQ 1025, 1026 (TTAB 1984); and U.S. Shoe Corp. v. Oxford Industries, Inc., 165 USPQ 86, 87 (TTAB 1970). Such products, as stated by the Board in B. Rich's Sons, Inc. v. Frieda Originals, Inc., 176 USPQ 284, 285 (TTAB 1972), "are closely related goods which could be purchased in the same retail outlets by the same classes of purchasers and often during the same shopping excursion to complete an ensemble". Applicant, in fact, admits that the respective goods herein are "overlapping products". Consequently, the only issue to be resolved is whether the respective marks are so similar that the contemporaneous sale

⁵ Both applicant and the Examining Attorney have cited various dictionary definitions in their briefs. We have considered such definitions inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); and University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1992), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

thereunder of shoes and a variety of items of clothing would be likely to cause confusion as to origin or affiliation.

Applicant argues that the Examining Attorney has erred in concluding that confusion is likely because "she [has] ignored the massive contribution in meaning, connotation, and visual recognition that the 'rowing' design makes to the overall commercial impression the SAHARA CLUB composite mark," an element which is not present in applicant's "SAHARA" mark. Applicant contends that when considered in their entirety, the respective marks are "easily distinguishable" in commercial impression and, thus, "the marks themselves are not confusingly similar".

Specifically, applicant asserts that, in addition to the differences in sound between the marks as a result of the presence of the word "CLUB" in registrant's mark, the connotations of such marks differ on account of the incongruity introduced by the "rowing design" in registrant's mark. According to applicant, "[w]hen the impression created by the entire SAHARA CLUB mark is correctly analyzed, it is not at all similar to that of applicant's mark" because:

The word "Sahara" alone denotes "the great desert of Libya or Northern Africa." The Compact Edition of the Oxford English Dictionary at 2621 (1979) [hereinafter O.E.D.]. Further, "Sahara" connotes the attributes of that desert region, namely aridity, barrenness, and lack of population. See id. at 697 ("desert" defined as "uninhabited ... tract of country; now conceived of as ... waterless and treeless."). The word "club" denotes "an association formed to combine the operations of persons interested in the promotion or prosecution of some object; the purpose is often indicated in the title." Id. at 444. Accordingly, "Sahara Club" alone suggests a

group of people organized to study, discuss, or perhaps preserve the Sahara desert (cf. the Sierra Club). Thus, when the "rowing" design is ignored, the Examining Attorney's conclusion that SAHARA CLUB means "those who like SAHARA" could be sound.

But this conclusion is only possible if the rowing design is ignored in this analysis, which it clearly may not be. And when the rowing design is considered at all, it becomes obvious that [the] SAHARA CLUB composite mark cannot refer to "those who like SAHARA"; the composite mark can only refer to some type of rowing club. Obviously, it is impossible to row a boat--much less to establish a rowing club--in a desert, and the Examining Attorney's conclusion that the three elements of "Sahara," "Club," and a rowing design somehow add up to a desert reference is nonsensical.

Indeed, as used in the SAHARA CLUB mark, the word "Sahara" loses all definable meaning. It certainly does not connote the desert region it suggests when used alone in the SAHARA mark. Instead, SAHARA CLUB apparently suggests that the clothing to which it is applied is the type worn by members of rowing clubs and perhaps other of the same social class. Thus, even though SAHARA and SAHARA CLUB plus rowing design share one element, when the connotations of the non-shared elements, including the rowing design, are given their proper emphasis, the total marks create very different commercial impressions. Cf. *Squirtco. v. Thomy* [sic] Corp., 697 F.2d 1038, 1041 (Fed. Cir. 1983) (SQUIRT SQUAD confusingly similar to SQUIRT because "Squirt" retained its lexicographical identity when used with "Squad").

Applicant, in this regard, further contends that, "[i]n addition to reshaping the impact created by the SAHARA CLUB mark, the rowing design emphasizes the differences in wording between that mark and the SAHARA mark" inasmuch as:

The "rowing" symbol itself evokes the idea of a "rowing club." See O.E.D. at 2590 (listing "rowing-club" as one of the usual uses of [the] word "rowing"). Indeed, the design

appears to show two members of a rowing club enjoying their favorite sport. Because there is no counterpart to the rowing symbol or the word "club" in the SAHARA mark, that design emphasizes these important differences between the two marks, further lessening the possibility that these marks would be confusingly similar.

The Examining Attorney, on the other hand, maintains that confusion is likely since, as stated by the Board in *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1534 (TTAB 1994): "Although consumers may well note the differences in the marks, they will assume that the differences indicate variant marks of a single source, rather than identify separate sources for the [goods]." As support for her position, the Examining Attorney cites the following definitions from the The Random House Compact Unabridged Dictionary (Special 2d ed. 1996), which defines "Sahara" at 1691 as "1. a desert in N Africa, extending from the Atlantic to the Nile valley ... 2. any arid waste" and lists "club" at 391 as, inter alia, "2. a group of persons organized for social, literary, athletic, political, or other purpose".

In view of such definitions, the Examining Attorney contends that, when considered in their entirety, neither the word "CLUB" nor the design elements in registrant's mark change the meaning or connotation of the word "SAHARA" therein from that of such word alone, as used in applicant's mark. The Examining Attorney, in this regard, argues that:

The term SAHARA, which is arbitrary as applied to footwear and clothing, forms the strong common element of both marks. The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The

issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP section 1207.01(b).

The addition of the term CLUB does not change the commercial impression of the term SAHARA. As shown by the dictionary definition, a "club" is a group bound by a common purpose. Use of the term CLUB with SAHARA reflects the impression of SAHARA because a SAHARA CLUB will be perceived to be a group interested in the SAHARA. The commercial impression created by the marks SAHARA and SAHARA CLUB is the same because they both primarily denote SAHARA. *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994) (ROAD KILL CLUB OF AMERICA and design for t-shirts, sweatshirts and pullovers held confusingly similar to ROAD KILL CATERING for t-shirts, sweatshirts and aprons).

Nor does the addition of the design element change the commercial impression of the SAHARA CLUB mark as a whole. The design of two people rowing is about a third of the size of the words SAHARA CLUB, and appears underneath it. The size and shape of the scull are almost identical to the underlining of the SAHARA CLUB words. The design is not a dominant part of the mark as a whole.

In addition to being visually unimposing, the design element generally is not the part of the mark used by consumers when requesting the goods. When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976). Moreover, because the applicant's mark is typed, and thus not restricted to a particular stylization, the literal portions [of the respective] marks ... could be presented in a way which

emphasized their similarities. "Presentation of a mark for registration in typewritten form means that the mark may be displayed in any style lettering, including, presumptively, the same style as that used by the [other party]." *In re Mars, Inc.*, 221 USPQ 1185 ... (TTAB 1983) *citing Pfizer, Inc. v. Cody John Cosmetics, Inc.*, 211 USPQ 64, 68 (TTAB 1981).

While we concur with applicant that the presence of the sculling or rowing design in registrant's "SAHARA CLUB" and design mark lends an element of incongruity or whimsy to such mark which is absent from applicant's "SAHARA" mark, we agree with the Examining Attorney that neither the design features nor the word "CLUB" in registrant's mark alters the meaning or connotation of the term "SAHARA". As used in registrant's mark, the term "SAHARA" has a meaning identical to that of applicant's mark, and it is precisely because of such identity in meaning that the design of two rowers in a scull creates a whimsical incongruity in registrant's mark.

Nevertheless, as pointed out by the Examining Attorney, the sculling or rowing design is plainly a subordinate element when registrant's mark is considered in its entirety. The words "SAHARA CLUB" in such mark, as the Examining Attorney observes, appear in a much larger size and style of lettering, and are far more visually prominent, than the design of two rowers in registrant's mark. The words "SAHARA CLUB," as the sole literal element in registrant's mark, would also be used by purchasers and potential customers to call for or inquire about registrant's items of wearing apparel.

Consequently, while visual and aural differences are apparent on a side-by-side comparison of registrant's "SAHARA CLUB" and design mark and applicant's "SAHARA" mark,⁶ such differences are insufficient to distinguish the marks since overall they are substantially similar in commercial impression. Both marks essentially convey the notion of the Sahara desert, notwithstanding the inharmonious or whimsical element lent to registrant's mark by the sculling or rowing design, since the term "CLUB" in registrant's mark is suggestive of a collection of wearing apparel which would appeal to people who like the same styles or fashions. Accordingly, and in light of the closely related nature of shoes and items of clothing, we conclude that members of the purchasing public, even if they were to notice the differences in the respective marks, would be likely to believe, upon encountering applicant's substantially similar mark "SAHARA" for shoes, that applicant's goods constitute a new or expanded product line from the same source as the various items of clothing offered by registrant under the "SAHARA CLUB" and design mark.⁷

⁶ A side-by-side comparison, as correctly noted by the Examining Attorney, is not the proper test to be used in determining the issue of likelihood of confusion since it is not the ordinary way that consumers will be exposed to the marks. Rather, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the consequent lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is thus on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks or service marks. See, e.g., *In re United Service Distributors, Inc.*, 229 USPQ 237, 239 (TTAB 1986); and *In re Solar Energy Corp.*, 217 USPQ 743, 745 (TTAB 1983).

⁷ See, e.g., *Avon Shoe Co., Inc. v. David Crystal, Inc.*, 279 F.2d 607, 125 USPQ 607 (2d Cir. 1960), *cert. denied*, 364 U.S. 909, 127 USPQ 555

Decision: The refusal under Section 2(d) is affirmed.

G. D. Hohein

B. A. Chapman

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board

(1940) ["HAYMAKERS" for women's shoes held confusingly similar to "HAYMAKER" for women's sportswear, including blouses, shirts, skirts and dresses]; In re Kangaroos U.S.A., supra ["BOOMERANG" and design for men's shirts found confusingly similar to "BOOMERANG" for athletic shoes]; U.S. Shoe Corp. v. Oxford Industries, Inc., supra ["COBBIES" for shoes held confusingly similar to "COBBIES BY COS COB" for women's and girls' shirt-shifts]; and B. Rich's Sons, Inc. v. Frieda Originals, Inc., supra ["RICH'S CHEVY CHASERS" for shoes found confusingly similar to "FRIEDA'S CHEVY CHASE ORIGINALS" for women's knitwear, namely, dresses, suits, skirts and blouses].